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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/176,077	10/20/1998	ROBIN ARTHUR GREEN	CA9-98-038	7754

25259 7590 10/04/2004

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EXAMINER
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BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/04/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/176,077  
Filing Date: October 20, 1998  
Appellant(s): GREEN, ROBIN ARTHUR

**MAILED**  
OCT 04 2004  
Technology Center 2100

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Robert A Voigt, Jr.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed: June 14, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

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**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

Claims 21-32, and 39, 41 are allowed.

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows: Claims 1-8, 10, 11, 13-20, 33-38, and 40 are pending. Claims 1-8, 10, 11, 13-20, 33-38, and 40 stand rejected.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Appellant's arguments regarding items C and D are moot in view of currently allowed subject matter.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that the pending claim groupings do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,826,025	GRAMLICH	10-1998
6,243,722	DAY ET AL.	6-2001
6,054,990	TRAN	4-2000
6,041,335	MERRITT ET AL.	3-2000

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 10, 16-20, 33, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich, U.S. Patent No. 5,826,025 issued October 1998, in view of Day et al. (hereinafter Day), U.S. Patent No. 6,243,722 issued June 2001 (cited in a previous action).

In regard to independent claim 1, Gramlich teaches an annotation overlay system of storing and managing a set of "annotation overlays" indicative of commentary associated with a requested source document.

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file (Gramlich Abstract, column 2 lines 65-67 to column 3 lines 1-2, also column 3 lines 9-13; compare with claim 1 preamble *"for storing and managing a set of comments associated with a source file, comprising"*).

Gramlich teaches a Web browser which is used to request source files (source URLs) via a source message (Gramlich Figure 1, also column 2 lines 65-67 to column 3 lines 1-2, column 4 lines 42-46, 61-64). Although the original document is requested using unmodified protocols (i.e. HTTP), Gramlich does not specifically teach that the requests to the overlay sources (Figure 1 item 116) are sent using unmodified protocols. However, Day teaches a comment review system whereby comments are entered and stored separately from the original document, said comments sent utilizing a typical browser using typical protocols (Day, Abstract, Figure 6, 7, column 4 lines 18-25, column 5 lines 45-49, column 7 lines 22-38, column 8 lines 53-60; compare with claim 1 *"means for requesting the source file using unmodified standard messaging protocols"*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Day's unmodified browser's use of sending (source) comments, to Gramlich's sending of source data to the annotation proxy (i.e. Gramlich Figure 1 items 114, 116), providing Gramlich the benefit of capitalizing on the ubiquity of (typical) web browsers (see Day column 7 lines 27-28).

Gramlich does not specifically teach a *"file review system"*, as claimed. However, Gramlich teaches that it is important that Web users be able to comment on the content of a Web document, as well as view the commentary of others, providing the claimed equivalent of a file review system (Gramlich column 1 lines 60-67; compare with claim 1 preamble *"A file review system..."*). It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Gramlich's system to be used for document review purposes, providing the benefit of critical review of published documents.

Gramlich teaches retrieving source documents in a Web browser (indicative of an HTML file) (Gramlich Abstract, column 3 lines 65-67, column 4 lines 43-50; compare with claim 1 *"means for accepting data from the source file....source file as a markup file,"*).

Gramlich teaches annotation overlay groups encapsulating annotation overlays associated with a source document file (Gramlich column 3 lines 9-13, column 11 lines 54-61; compare with claim 1 *"means for creating a comment file containing data....comments associated with the source file"*).

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Gramlich teaches input and acceptance of new annotation overlays directly to one or more overlay groups. Gramlich also teaches a grouped set of overlays associated with a document. The overlay groups are updated with new contributions accordingly (Gramlich column 7 lines 35-45, column 8 lines 40-50; compare with claim 1 *“means for accepting new comments for inclusion....to correspond to the complete set of comments”*).

Gramlich teaches a source document in a Web browser (indicative of an HTML file) (Gramlich Abstract, column 3 lines 65-67, column 4 lines 43-50), as well as associated annotation overlays, said overlays also written in HTML (Gramlich column 8 lines 35-40). Gramlich also teaches an annotation overly proxy (AOP), which dynamically combines a source document with associated annotation overlays, the resulting merged document can be shown via browser by directly displaying the inserted overlay text at the insertion point within the source document (Gramlich column 11 lines 25-29, column 12 lines 34-36, column 13 lines 8-16, also Figure 5; compare with claim 1 *“means for generating a hypertext document from the markup file....the set of comments associated with the source file”*).

Gramlich teaches display of a merged hypertext document via a browser (Gramlich Abstract, column 3 lines 17-22 column 4 lines 43-47; compare with claim 1 *“means for communicating the hypertext document to a browser for display.”*).

**In regard to dependent claim 10,** Gramlich teaches addition of an HTML tag indicative of a hypertext link at a defined subsection of the source HTML document, said hyperlink referencing an overlay file from an overlay group (Gramlich column 13 lines 1-10; compare with claim 10).

**In regard to dependent claim 16,** Gramlich teaches a magazine model, whereby authors submit annotations to an editor for incorporation into overlay groups, said groups restricted to subscribed members (Gramlich column 8 lines 46-54; compare with claim 16).

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**In regard to dependent claim 17**, the limitation of defined cutoff dates and restricting comments on dates past said cutoff date, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gramlich, because Gramlich teaches selling subscriptions to overlay groups (in a magazine model), suggesting the use of cutoff dates and deadlines for article submission and user/author inclusion (Gramlich column 8 lines 40-54; compare with claim 17), providing a user of Gramlich the benefit of providing a periodical magazine structure.

**In regard to dependent claim 18**, Gramlich teaches authors contributing annotation overlays associated with sequenced insertion positions within a source document (Gramlich column 3 lines 9-13, column 8 lines 40-54, column 13 lines 1-9; compare with claim 18).

**In regard to dependent claims 19-20**, Gramlich teaches icons as hypertext links within a merged document (Gramlich column 13 lines 8-13; compare with claim 19).

The limitation of accumulating/displaying statistics, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gramlich, because Gramlich teaches selling user subscriptions to overlay groups (in a magazine model), suggesting the use of user/author statistics (i.e. subscriber lists) (Gramlich column 8 lines 40-54; compare with claim 20), providing a user of Gramlich the benefit of providing statistics for a periodical magazine structure.

**In regard to independent claim 33**, claim 33 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

**In regard to dependent claim 40**, claim 40 reflects the computer program product comprising computer executable instructions for performing the methods as claimed in claim 33, and is rejected along the same rationale.

**Claims 2-8, 11, 13-15, 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich, and Day as applied to claims 1 and 33 above, and further in view of Tran, U.S. Patent No. 6,054,990 issued April 2000.**

**In regard to dependent claim 2,** Gramlich does not specifically teach representation of a source file as a linked list. However, Tran teaches insertion of annotation text into linked list objects (Tran column 15 lines 30-39; compare with claim 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Tran to Gramlich, because of Tran's taught advantage of linked lists, providing a user of Gramlich with a way to dynamically store files.

**In regard to dependent claims 3-6** Gramlich teaches merging of HTML based overlays with HTML source documents (see rejection of claims 1 and 2, above), as well as displaying an icon (symbol) or hyperlink cue at the overlay insertion point within a merged document, reflective of an annotation insertion point. Gramlich also teaches addition of HTML tags within the merged document, and the hyperlink cue (tag) at said insertion point causes the overlay to appear subsequent to hyperlink activation (Gramlich column 12 lines 25-35; compare with claims 3-6).

**In regard to dependent claims 7, 8,** Gramlich does not specifically teach representation of a source file as a linked list. However, Tran teaches insertion of annotation text into linked list objects (Tran column 15 lines 30-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Tran to Gramlich, because of Tran's taught advantage of linked lists, providing a user of Gramlich with a way to dynamically store and manipulate objects.

In addition, Gramlich teaches insertion of HTML tags at the end of each sentence, and deletion of a pattern or range of words surrounding a pattern (Gramlich column 9 lines 20-25, column 13 lines 1-9). Compare the above with claims 7, 8.



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In regard to dependent claim 11, Gramlich teaches HTML comprising various definable tags (Gramlich Abstract, column 3 lines 65-67, column 4 lines 43-50). Gramlich also teaches inserting information into a merged document at a location defined in an action field, as well as an icon at the point of insertion (Gramlich column 12 lines 32-42). Compare the above with claim 11.

In regard to dependent claims 13-15, Gramlich teaches a subset of annotation overlays associated with a document, said annotations referenced by patterns, said annotations also referenced by authors and content (Gramlich column 7 lines 35-40, column 8 lines 40-51, 54-67; compare with claims 13-15).

In regard to dependent claims 34, 35, 36, 37, 38, claims 34, 35, 36, 37, 38 incorporate substantially similar subject matter as claimed in claims 2, 3, 4, 5, 6, respectively, and are rejected along the same rationale.

**(11) *Response to Argument***

Appellant's arguments C and D spanning pages 22 at bottom, to page 36, of the Appeal Brief (hereinafter the Brief), are moot in view of allowed subject matter (see paragraph 3, above), therefore said arguments will not be addressed by the examiner.

Beginning with page 5 of the Brief, Appellant argues the following issues, which are accordingly addressed below.

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A. “Claims 1, 10, 16-20, 33, and 40 are not properly rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich in view of Day.” (page 5 of the Brief)

The examiner respectfully disagrees. Appellant argues on pages 5-7 of the Brief that the examiner has not presented any objective evidence for combining Gramlich and Day. Appellant also argues that the motivation originates from the secondary reference (Day) to solve its problem.

It is respectfully submitted that motivation for combining references can originate from the secondary reference, primary reference, or from the knowledge of the skilled artisan.

Gramlich is directed towards applying a set of annotation overlays to a base HTML document, said annotations reflecting possible critical comments and information from various users (i.e. authors, etc.) for other users to see and possibly review. As is explained in the rejection of representative claim 1, the examiner uses Gramlich to teach/suggest all claimed limitations except “*means for requesting the source file using unmodified standard messaging protocols*”. The examiner admits that, although most of Gramlich’s invention utilizes a typical prior art web browser (see Gramlich column 4 lines 42-46, and lines 58-60), Gramlich’s browser also issues a source message request which is a new message (i.e. a message not currently used by existing web browsers – see Gramlich column 4 lines 61-63). Day is a network based document review tool using comment classification. Day teaches its invention using a typical browser, since the examiner’s specific citings in Day point to the use of a typical browser using HTTP protocols, etc. The examiner applies Day’s unmodified browser use of sending (source) comments, to Gramlich’s sending of source data to the annotation proxy (i.e. Gramlich Figure 1 items 114, 116), providing Gramlich the benefit of capitalizing on the ubiquity of (typical) web browsers (see Day column 7 lines 27-28). In other words, Gramlich’s browser is modified so that its source call would be considered an “unmodified” message, along with the other HTTP messages supported by typical browsers.

It is well established that most people use relatively updated versions of browsers, which are necessary for interpreting new HTML tags, XML, etc. Part of the examiner’s use of “ubiquity” lies in the notion that

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HTML standards change over time (i.e. HTML 2.0, 3.0, 3.2, etc.), and since each new browser release incorporates these new standards accordingly, typical “ubiquitous” browsers people use are generally more recent versions. In this sense it is not unreasonable to interpret Day’s browser as a recent typical browser, which, when applied to Gramlich, provides Gramlich the benefit of a ubiquitous browser incorporating Gramlich’s (now standard) browser command call.

It is respectfully noted that both references deal with associating comments and/or annotations with base documents. Appellant argues portions of Gramlich and Day which are not claimed by Appellant (i.e. “comments may be separately stored”, etc.). Even if Appellant were to claim this, Day teaches separately storing comments in a comment database, and Gramlich teaches annotation overlay files stored separately from the source document, said overlay files called and merged with said source accordingly. Appellant appears to be arguing bodily incorporation of references. It is the examiner’s opinion that the test of obviousness is what the combination of references suggest to the skilled artisan. The combination of Gramlich and Day teaches and/or fairly suggests Appellant’s invention as applied to the claims in the Final rejection.

Appellant argues on page 8 of the Brief that the references do not teach “system user are uniquely identified in the system...based on the unique identity of system users” (claim 16). As explained in the Final rejection, Gramlich teaches a magazine model, whereby authors submit annotations to an editor for incorporation into overlay groups, said groups restricted to subscribed members (Gramlich column 8 lines 46-54). It is well established that editors of magazines (or peer reviewed journals, etc. which depend upon author submissions), typically restrict submissions only to authorized credentialed authors (one cannot submit an article to the New England Journal of Medicine unless one is at least an accredited doctor/researcher, etc., and must be prepared to prove their credentials to the editors). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret a “magazine” model as restricting submissions to uniquely identified users (i.e. only to established, accredited authors).

Appellant argues on pages 8-10 of the Brief that the references do not teach “the source file is associated with a defined cutoff date...past the cutoff date” (claim 17). As explained in the Final office action, the limitation of defined cutoff dates and restricting comments on dates past said cutoff date, would have been

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obvious to one of ordinary skill in the art at the time of the invention, in view of Gramlich, because Gramlich teaches selling subscriptions to overlay groups (in a magazine model), suggesting the use of cutoff dates and deadlines for article submission and user/author inclusion. The use of "selling subscriptions" can encompass the selling of a "block of time" in which (along with a set of magazine mailings) a particular set of good(s) and/or service(s) are available during said time period (i.e. as in a member of a society, or a block of airtime, etc.). Obviously, when said block of time ends, the typical user is restricted (i.e. cutoff) from said good(s)/service(s). In addition, magazine editors typically employ "cutoff dates" in order to meet publication deadlines. In view of the above, along with the teachings within the Final office action, it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Gramlich's teachings to teach and/or suggest Appellant's claimed limitations.

**B. "Claims 2-8, 11, 13-15, and 34-38 are not properly rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich in view of Day, and further in view of Tran." (page 11 of the Brief)**

The examiner respectfully disagrees. Appellant's arguments on pages 11-14 of the Brief are substantially directed towards the assertion that the examiner has not presented any objective evidence for combination, etc. Appellant's arguments are similar to those presented above. Appellant argues inability to combine along with non-objective motivation, etc., etc. It is respectfully submitted that motivation for combining references can originate from the secondary reference, primary reference, or from the knowledge of the skilled artisan.

Throughout the Brief, Appellant appears to be arguing bodily incorporation of references. As explained above, it is the examiner's opinion that the test of obviousness is what the combination of references suggest to the skilled artisan. The combination of Gramlich, Day, and Tran teaches and/or fairly suggests Appellant's invention as applied to the claims in the Final rejection (especially in regard to argument 2 on page 14 of the Brief).

The examiner's rebuttal to Appellant's arguments for argument within item A, above are equally applicable to Appellant's argument B (pages 11-22).

Tran is directed towards incorporating handwriting annotations, etc. to photographs, computer aided design (CAD) drawings, etc. The Tran reference is relevant since it teaches applying additional information (i.e. comments, etc.) to images, said invention can be applied to a computer network. Tran mentions that annotation is important to photography ("breathing life into the picture") (Tran column 2 lines 59-67). Tran also mentions that annotations/comments etc. are necessary when pictures are submitted for review (Tran column 3 lines 1-8). Tran teaches its invention can be applied to digital cameras (Tran column 5 lines 41-42), as well as applied to computers with drawings, and can use the Internet to gather information (Tran column 11 lines 25-52, column 23 lines 18-19, column 24 lines 25-33).

Tran teaches linked lists for storing information. It is well established that linked lists provide an advantage of dynamic memory allocation, the storage limit defined by the limit of the computer's memory. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply Trans's linked list to Gramlich, providing Gramlich said advantage. In addition, since all computer instructions, files, etc. can be broken down to a basic binary collection of "zeros and ones" (binary) within a computer, the hypertext file, when stored, is analyzed by a computer as a collection of binary data (i.e. 110101010, etc.).

It is respectfully submitted that Tran can be combined with Gramlich. Both references associate annotations with documents or images. Gramlich deals with HTML, which is hypertext that can (and typically does) include various multimedia (i.e. text, images, sound, movies, etc.). There is no reason why Trans's annotation system cannot be applied to a web page of Gramlich, providing Gramlich multimedia web pages (i.e. handwritten messages, annotations, etc. applied to CAD image drawings on a web page). Tran teaches a mobile computer, however, Gramlich's invention can easily be implemented on a mobile computer (i.e. laptop) as well. Gramlich teaches a hypertext representation of a source file. The examiner applies a linked list structure to the hypertext files of Gramlich. Both are combinable, since both deal with annotating document/images, both are associated with the Internet, see above, also Final Rejection.

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Appellant's arguments on pages 16-21 are similar to those presented above, and have been previously addressed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

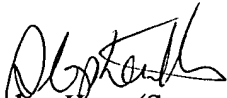


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September 30, 2004

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